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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/751,362

Filing Date: January 05, 2004

Appellant(s): NAIR ET AL.

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Charles R. Matson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05 July 2011 appealing from the Office action mailed 01 February 2011.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1, 9, 1122-30 and 32-34 are pending in the application;

Claims 25-29 are withdrawn from consideration as being drawn to a nonelected invention;

Claims 1, 9, 11, 22-24 and 32-34 are rejected under 35 USC 103(a).

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

#### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

#### **(8) Evidence Relied Upon**

5,818,719	BRANDON	10-1998
5,503,076	YEO	04-1996
6,558,499	PARGASS	5-2003
WO00/13632	STAVRULOV	03-2000

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 9, 11, 22-24 and 30, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al (US 5,818,719) in view of Yeo et al (US 5,503,076) and further in view of Pargass et al (US 6,558,499 B1).

**With respect to independent claim 1**, Brandon discloses an absorbent product 10 comprising:

a topsheet 36, a backsheet 34, and an absorbent core 32 disposed between the topsheet 36 and the backsheet 34, the topsheet 36 and the backsheet 34 defining a first waist region 26 longitudinally opposed to a second waist region 28, wherein the first and second waist regions

26, 28 are connectable with each other to form a waist opening 22, each of the absorbent articles further comprising a visible framing mark 74 and a printed graphic 38 printed directly on the backsheet 34, see Figures 1, 2, 2A and 3-4, see column 3, lines 49-53; column 5, lines 56-61; column 6, line 47 and lines 63-67; column 10, lines 15-20 and lines 37-45; see also column 7, lines 6-28; and

wherein the printed graphics of each of the absorbent articles can be different from the graphic of each of the remaining absorbent articles, and wherein all of the printed graphics of the absorbent articles can have a predetermined association, see column 10, lines 32-34; column 3, lines 15-39 and lines 58-61; column 7, lines 6-24 and lines 66-67; column 10, lines 33-34;

wherein the backsheet 34 of each of the absorbent articles comprises a film material 66 extending from the first waist region 26 to the second waist region 28 and having a body facing surface and a garment facing surface, and wherein each printed graphic is printed directly on the garment facing surface of the material, see column 9, lines 35-41 with column 3, lines 49-50 and column 6, lines 64-65 with Figure 2A; and

wherein the backsheet 34 of each of the absorbent articles further comprises a nonwoven material 92 joined with the garment facing surface of the film material 66, and where the printed graphic 38 is visible through the nonwoven material 92, see column 10, line 61 to column 11, line 3 with column 3, lines 45-50; column 5, lines 50-55; Figures 1-2A; and

wherein the predetermined association includes a common theme, see column 7, lines 8-10 and lines 17-24.

Brandon discloses the claimed invention except for expressly disclosing microporous film material. At column 5, lines 50-55, Brandon discloses that the materials comprising the

layers of the article can be film materials and also can be permeable to air but not permeable to liquids, films that are permeable to air but not to liquids are known in the diaper art as "breathable" because they permit air and vapor to circulate through the diaper / training pant(s) due to the presence of small micropores in the film material that are small enough to permit vapor passage but are too tiny to permit liquid passage and thus prevent urine liquids from leaking out through the diaper in order to provide diapers that prevent diaper rash and skin irritations caused by damp skin that is closed off from air flow.

Yeo, at column 5, lines 35-55, teaches and thus provides motivation for backsheets having the properties of vapor permeability and liquid impermeability that are described by Brandon. Yeo states that if cost is not critical, it may be desirable to provide a breathable or microporous film as a backsheet layer 14 and also states that breathable films are well known.

Thus, microporous films are well known in the diaper art for providing breathable and liquid impermeable properties that are desirable for diaper backsheets that are liquid impermeable and prevent diaper rash.

Yeo, at column 8, lines 44-48, further teaches that it is preferable to print graphics directly on microporous film surfaces because they provide a smoother substrate surface to print on than non-woven surfaces and therefore such films permit greater print pattern definition and display improved graphics.

Yeo teaches film 14 and nonwoven 12 laminates for diaper backsheets 40 comprising nonwoven material 12 joined with garment facing surfaces of films that can be microporous films 14 with graphics 16a-16c printed directly on the garment facing surface of the film material and the printed graphic is visible through the nonwoven material, see column 3, lines 50-55;

column 4, lines 20-25 and lines 31-34; column 5, lines 35-54. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the microporous film of Yeo for the film of Brandon since Yeo states that the benefit of such films are that their breathable and liquid impermeable properties make them desirable for diaper backsheet and that their film surfaces provide a better substrate to print graphics on which are objects of Brandon.

Brandon discloses the claimed invention except for that the absorbent product comprises a package and at least n absorbent articles contained in the package, wherein n is greater than 10.

As an initial matter, the examiner notes that absorbent articles intended for hygiene and sanitary use such as diapers, training pants, incontinence articles, and catamenial articles such as sanitary napkins and tampons are sold to purchasers in packaging to protect the sanitary articles and maintain their hygiene because they are used in direct contact with a wearer's urogenital skin and sensitive membrane tissues of the urogenital region. One of ordinary skill in the art would recognize that sanitary and hygiene articles are provided in packaging that protects the articles from environmental dirt and contamination and keeps the articles in a clean, pristine condition prior to their use and placement in the urogenital region of a purchaser in order to provide the purchaser with a clean and sanitary article of hygiene.

Additionally, with respect to the claimed n number of articles contained in the package, in light of the well known practice of packaging items in a manner most convenient for a purchaser, providing articles to the purchaser in one package as opposed to two packages or three packages is not a novel or patentable feature, therefore the single package or two packages limitation does not lend additional patentable weight and is an obvious modification. *Ormco*

*Corporations and Allesse Orthodontic Appliances, Inc. v Align Technology, Inc.* (Fed. Cir. 05-1426, 8/30/2006).

Furthermore, one of ordinary skill in the art would recognize that hygiene articles such as diapers, training pants, incontinence and catamenial pads and sanitary napkins that absorb bodily fluids are changed many times throughout a day as they become soiled and saturated with bodily fluids and their absorbent capacity is exhausted. One of ordinary skill in the art would recognize that making many trips a day to a retailer store each time a soiled saturated article needs to be replaced with a new article would not be convenient for a purchaser, thus such articles are not customarily sold individually or singly but are rather customarily sold packaged in numbers and quantities anticipated to last a purchaser throughout many changes and replacements of soiled articles with new unused articles. Therefore providing diapers, sanitary napkins and other such articles in packages containing sufficient numbers and amounts of articles to last a purchaser between trips to a retailer store is recognized as a manner most convenient for a purchaser of hygiene articles.

Pargass teaches and thus provides motivation for absorbent products comprising packages and at least n absorbent articles wherein n is greater than 10; see column 5, lines 1-5; column 15, lines 45-67 and column 16, lines 1-2. Thus Pargass expressly teaches that a package of articles can include any desired number of absorbent articles, each containing a graphic, and can include any desired number of graphics. Pargass further teaches that absorbent articles comprising visible framing marks 21a and graphics 21 and each of the printed graphics can be different from the graphic of the remaining articles, see Abstract; see also column 5, lines 5-6 teaching the graphics 21 can be repeating; thus Pargass teaches that the graphics can each be

different from the graphic of each of the remaining articles in the package, or can be repeating, as desired by the packager of the articles, and thus these limitations are known in the art.

Pargass, at column 2, lines 9-13, teaches that providing graphics having a predetermined association is known the art as taught by US 5,286,543 to Ungpikyakul; '543 at column 3, lines 6-11; column 18, lines 20-21; column 30, lines 29-35 discloses graphics having a predetermined association with a common theme, see also '543 at column 1, lines 18-19; column 6, lines 55-60; column 8, lines 19-28 and lines 35-44.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the articles in packages containing n articles as taught by Pargass since Pargass states that the articles can be packaged in variety packs that can contain any desired number of absorbent articles and any desired number of graphics thus the manner in which the articles are packaged for purchase is a matter of choice because when there is a variety of possible selections as to how to package the articles and their graphics it means that the designer can choose any selections as desired.

**With respect to claim 9**, as best depicted in Figures 1-4, Brandon discloses the common theme include cartoon characters, transportation means, animals and seasonal themes, see column 7, lines 8-11 and lines 19-20; column 3, lines 29-30; the examiner notes that the theme of the graphics is a limitation is drawn to the content of the graphics and thus are drawn to the content of printed matter and are examined in accordance with MPEP § 2112.01, III.

**With respect to claim 11**, Brandon discloses the claimed invention except for n is selected from 11 to 120. Pargass teaches n can be any desired number of absorbent articles and thus capable of being selected from 11 to 120, see column 5, lines 4-5 with column 15, lines 45-

67. The examiner notes that selecting the number of articles to include in a package is a mental determination, i.e. the result of a mental process such as deciding how to market the articles for sale to consumers; however, mental processes or processes of human thinking are not patentable even if they have practical application.

In light of the well known practice of packaging items in a manner most convenient for a purchaser, providing articles to the purchaser in one package as opposed to two packages or three packages is not a novel or patentable feature, therefore the single package or two packages limitation does not lend additional patentable weight and is an obvious modification. *Ormco Corporations and Allesse Orthodontic Appliances, Inc. v Align Technology, Inc.* (Fed. Cir. 05-1426, 8/30/2006).

**With respect to claim 22**, Brandon discloses the claimed invention except for expressly disclosing that each of the printed graphics is an inkjet printed graphic. Brandon discloses that the graphics are printed on the film 66 of the backsheet 34, thus providing motivation for the genus of printing the graphics but remains silent on the species of inkjet methods of printing. Yeo, at column 8, lines 66-67 and column 9, lines 5-10, teaches and thus provides motivation for inkjet printing graphics for absorbent articles. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Brandon by inkjet printing as taught by Yeo since Yeo states, at column 8, lines 51-52 and lines 66-67 and column 9, lines 5-10, that the benefits of using inkjet printing are that the process can handle multi-color printing, is simpler, with no fouling of equipment and provides bright colors and sharp patterns when printed directly on film.

**With respect to claim 30**, claim 30 differs from claim 1 only in that claim 1 recites the additional limitation that the backsheet comprises a microporous film material while claim 30 lacks this limitation; see claim 1, *supra* for detailed analysis of all claimed limitations recited in claim 30.

**With respect to claim 32**, Brandon discloses the claimed invention except for expressly disclosing that each of the printed graphics is an inkjet printed graphic. Brandon discloses that the graphics are printed, thus providing motivation for the genus of printing the graphics but remains silent on the species of inkjet methods of printing. Yeo, at column 8, lines 66-67 and column 9, lines 5-10, teaches and thus provides motivation for inkjet printing graphics for absorbent articles. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Brandon by inkjet printing as taught by Yeo since Yeo states, at column 8, lines 51-52 and lines 66-67 and column 9, lines 5-10, that the benefits of using inkjet printing are that the process can handle multi-color printing, is simpler, with no fouling of equipment and provides bright colors and sharp patterns when printed directly on film.

**With respect to claims 23 and 24**, Brandon discloses the claimed invention except for microporous film **as recited in claim 23 and claim 24**. Brandon discloses that the sheet of material 66 extending from the first to second waist region 26, 28 is film material and that the graphic 38 is printed directly on the garment facing surface of the film **as recited in claim 23**, see column 9, lines 35-45. Brandon discloses a nonwoven material 92 joined with the garment facing surface of the film 66 and the printed graphic is visible through the material **as recited in claim 24**, see column 10, lines 61-67; column 11, lines 1-5 and lines 29-30.

Yeo teaches microporous film 14 and graphics 16a-16c printed directly thereon, a nonwoven material 12 joined thereto and the graphic is visible through the material 12, see Figures 2 and 3; column 4, lines 20-30. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the film of Brandon as microporous film as taught by Yeo since Yeo states, at column 4, lines 21-30, that the benefits of using microporous film is that they are breathable which is an object of Brandon at column 5, lines 53-55, and that they have smooth printing substrate surfaces to support multi-colored printed graphics that provide greater print pattern definition and that the nonwoven material protects the graphics from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Yeo and Pargass and further in view of Stavrulov (WO 00/13632).

**With respect to claims 33 and 34,** the combination of Brandon, Yeo and Pargass discloses the claimed invention except for the graphics are printed in a randomly selected order and the n absorbent articles are stacked in the package in a randomly selected order **as recited in claims 33 and 34.** Brandon discloses the graphics are printed directly on the backsheet of the articles **as recited in claim 33;** the graphics are printed directly on each sheet of the absorbent articles **as recited in claim 34.**

With respect to the limitation that the articles are stacked in the package in a randomly selected order, the articles of Brandon are capable of being placed in a package in a randomly selected order because the selected order in which a seller of the articles decides to places the articles in the package is not a structural limitation of the product but is the result of a mental

decision on how to market and package the articles in a manner attractive to a purchaser. Deciding to package the diapers in randomly selected orders or in non-randomly selected orders is the result of a mental process of decided how to distribute and sell the diapers as a marketing strategy of offering for sale products packaged in a manner which makes the purchase thereof attractive to a consumer.

By way of non-limiting example, the diapers in the package can be taken out of the package and rearranged in entirely different orders that are non-random or random; thus rearranging their order in a package does not change the structure of the diapers because the structural elements of the diapers do not change when their order in the package is rearranged differently. Thus the orders in which the diapers are placed in the package do not affect the structure of the diapers.

Stavrulov teaches absorbent articles comprising graphics wherein each of the graphics is different from the graphic of each of the remaining articles and the graphics are printed in a randomly selected order and the articles are stacked in their package in the randomly selected order, see Examples 1-3 at pages 10-12 describing that any 30 or any 20 products are placed in a common packing then offered for retail and thus is random since the any 30 or any 20 products are not disclosed as being printed or stacked in the common packing in any particular or specific order that would be a non-random order, see also page 1; page 2, lines 20-22; page 3, lines 23-25; page 4, lines 28-29; page 5, lines 4-12.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the products or Brandon, Yeo and Pargass as taught by Stavrulov since Stavrulov states, at page 3, lines 23-25; page 4, lines 10-20, that the benefit of

packaging the articles in this manner is that this increases their attractiveness to a consumer purchasing the articles.

**(10) Response to Argument**

Appellant argues the following:

The combination of Brandon, Yeo and Pargass fails to teach or suggest all of the claim limitations of independent claims 1 and 30 because Brandon does not disclose a package or microporous film (Brief, page 4 of 16, paragraphs 3-4);

There was no apparent reason to combine and modify the asserted references in the fashion claimed (Brief, page 4 of 16, paragraphs 3 and 5);

Brandon does not disclose different graphics on diapers contained in a package (Brief, page 4, paragraph 5); the examiner has provided no reasoning why one of ordinary skill would modify Brandon to include a package containing 10 or more diapers (page 4).

**These arguments are not persuasive** because, although Brandon does not disclose packaging the diapers for sale, Brandon is directed to the manufacture of diapers and a reference preferably omits what is well-known in the art. It is well known to package hygiene and sanitary articles for shipping, transportation, storage and displaying on store shelves in packages because these absorbent articles intended for hygiene and sanitary use as diapers, training pants, incontinence and catamenial articles such as sanitary napkins and tampons are sold to purchasers in packaging to protect the sanitary articles from dirt, dust and environmental contamination and to maintain their clean hygienic state because they are used in direct contact with a wearer's urogenital skin and sensitive membrane tissues of the urogenital region.

Thus one of ordinary skill in the art would recognize that sanitary and hygiene articles are provided in packaging that protects the articles from environmental contamination and keeps the articles in a clean, pristine condition prior to their use and placement in the urogenital region of a purchaser in order to provide the purchaser with a clean and sanitary article of hygiene. Thus providing the diapers of Brandon in a package would be an obvious modification because diapers and hygiene articles are not sold unpackaged because they would be unfit for their intended use and a purchaser would not be inclined to purchase sanitary articles if they became soiled and contaminated during shipping and storage prior to use.

The asserted references are all analogous art concerned with providing graphics on diapers to attract consumer interest and make the products attractive to purchase because of their graphics, and are thus the combination of references is proper.

Although Brandon does not expressly disclose microporous film, Brandon discloses film and breathable films; microporous films are known for their breathable properties that prevent diaper rash while preventing leakage of urine. Yeo teaches that microporous films are desirable for diaper graphics for these reasons and also because they provide a smooth printing surface substrate for graphics such as those contemplated by Brandon and thus the combination of Brandon and Yeo is proper.

Appellants argument that the conclusion that the disclosure that graphics can be different provides motivation for different graphics on articles within a package is erroneous (page 5, paragraph is not persuasive because the examiner does not cite the disclosure that the graphics can be different as motivation for different graphics on articles within a package.

The cited art discloses that the graphics can be different for reasons of appealing to consumers to attract consumers to purchase the articles. The examiner does not cite the graphics as a reason to package the diapers; the examiner cites the well-known practice of protecting sanitary articles from becoming dirty and from contamination during shipping, and for packaging the articles in amounts that are convenient for a purchaser to last between shopping trips to purchase more articles is motivation to package the articles to keep them clean and minimize trips to the store as motivation to provide the diapers of Brandon in packages for the convenience and sanitary hygienic health of the purchaser.

Appellants argument that Pargass discloses a diaper having a graphic printed on a patch which may be joined with a backsheet (Brief, page 5, paragraph 3) and as such, Pargass does not teach or suggest printing graphics directly on a backsheet (page 7, paragraph 1) is not persuasive because the examiner does not cite Pargass for teaching printing graphics directly on a backsheet because Brandon discloses printing directly on a backsheet. The examiner cites Pargass for the explicit teaching that any desired number of diapers and graphics can be packaged in a set or pack of diapers for sale.

Appellants argument that the Yeo is cited as disclosing a microporous film and as such Yeo does not correct the deficiencies of Brandon and Pargass (page 7, paragraph 3) is not persuasive because Brandon discloses printing graphics directly on backsheets; Pargass teaches that diapers can be placed in packages in any number desired. Yeo is cited for the teaching that the breathable film contemplated by Brandon can be microporous film which is desirable for its breathability properties and providing a smooth printing surface substrate, thus Yeo is not cited for correcting any deficiencies of Brandon and Pargass but rather for the teaching of the

suitability of microporous films which are breathable and thus are among the various films contemplated by Brandon.

Appellants argument that the conclusion that the limitation that the graphics are different from each other is drawn to the content of printed matter is erroneous because a claim limitation relating to graphics that are different from each other is not drawn to the content of printed matter, when taken in the context of the language of the entirety of claims 1 and 30, limitations relating to absorbent article having graphics different from each other contained in a package are drawn to structural differences, not to the content of printed matter (page 7, paragraph 4) is not persuasive because Appellant has not set forth any reasons or explanations as to how the graphics comprise structural limitations of the diapers when the diapers are placed in the package. The assertion that the graphics comprise structural limitation of the diapers when the diapers are in the package, when taken in the context of the language of the entirety of claims 1 and 30 does not explain how the context of the language of the entirety of the claims renders the graphics as structural limitations when contained in a package, therefore, absent some reasoning as to the manner in which placing the graphics in a package comprises structural limitations of the articles, this argument is unpersuasive.

Appellants argument that the conclusion that the claimed common theme does not lend additional patentable weight because if articles were patented based on differences in graphics, multiple patents could issue for the same article by changing the content of the graphics cannot be sustained by conclusory statement, there must be some articulated reasons with some rational underpinning to support the legal conclusion of obviousness. Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the

content of the printed matter (page 7, final paragraph); Appellant believes that the examiner erroneously excises the claimed common theme from claims 1 and 30 without considering the claimed common theme in the context of the claims as a whole (page 8) is not persuasive because the examiner does not ignore the content of the printed matter, the content of the printed matter as presently claimed is disclosed in the cited art of record. However, the examiner has examined the content of the printed matter in accordance with the MPEP as follows:

With respect to printed matter, the critical question is whether any new and unobvious relationship functional relationship exists between the printed graphic and the substrate, as per MPEP § 2112.01, III. Here, both the instant and the prior art graphics are printed on microporous film with nonwoven material comprising the outer cover of the article and the printed graphic is visible through the nonwoven. Outer covers are known in the art to comprise laminates of films and nonwovens in multiple layers, and therefore the claimed graphics do not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*.

### **III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT**

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, \*\*>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included

instructions and a buffer agent, even though the content of the instructions differed.).

See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

MPEP § 2112.01, III.

It is well known in the packaging art to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or ornamental graphics to induce consumer interest in the article.

The cited art applied discloses the claimed content of the graphics, and therefore, absent evidence of any new and unobvious functional relationship between the printed matter and the substrate, the content of the graphics is disclosed in the cited art of record substantially as claimed.

Appellants argument that the Appellant argues that the limitation that the predetermined association includes a common theme is not a mental process (page 9, paragraph 4); claims 33 and 34 recite the structural limitations that define the articles stacked in a package in a randomly selected order is not merely a mental process because the claims do not recite a mental process as to how to decide to package the article in the package (page 9, paragraphs 5-6) is not persuasive because (1) the prior art discloses a common theme, see Brandon, see Stavrulov at page 9, lines 10-11; (2) the only reason provided by Appellant as explanation as to how the manner in which

deciding how to package the articles is not a mental process is that the claims do not recite that this is a mental process. However, merely stating that because the claims do not recite that this comprises a mental process is not a reasoning or explanation as why this is not a mental process, therefore this argument is unpersuasive.

Appellants argument that the articles of Brandon are capable of being placed in a package in a randomly selected order does not render the pending claims obvious (page 10) is not persuasive because the examiner does not assert that because the articles are capable of being placed in a package in the claimed order renders the claims obvious.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention" does not establish the invention's nonobviousness. *Dann v. Johnston*, 425 US 219 (1976).

The gap between the prior art and the claimed invention may not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art." *Id.* In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. Factors other than the disclosures of the cited prior art may provide a basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap.

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a).

*Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a).

*Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Appellants argument that the order the articles are arranged in the package is a structural limitation of the absorbent product and therefore does lend additional patentable weight (page 10, paragraph 2) is not persuasive because Appellant has provided no reasons or explanations as to how or why the manner in which the articles are arranged in the package comprises a structural limitation of the articles and thus argument is an assertion or statement that the order is

a structural limitation, thus absent any explanation or reasons as to how the order comprises a structural limitation this argument is not persuasive.

Appellants argument that the Pargass teaches away from the claimed invention as well as the combination with Stavrulov because Pargass teaches the articles with distinct repeating graphics (page 10) is not persuasive because the examiner does not cite Pargass for teaching the articles with or without repeating graphics, the examiner cites Pargass for teaching that articles can be packaged in any desired number.

Additionally, the examiner does not use the disclosure that Brandon teaches that the graphics printed on the diapers can be different from each other as motivation to package the diaper articles in packages. The examiner uses this as evidence that Brandon and Pargass are analogous art with respect to diapers that have graphics printed on them and thus are analogous art and the combination of Brandon and Pargass is proper.

With respect to the limitation of packaging the articles in a package of ten articles or more, it is well known in the absorbent article art that it is standard practice to package hygiene articles such as diapers and incontinence pads, sanitary napkins, tampons etc. in numbers greater than ten articles in a package, for sale to consumers. It is standard practice to include ten or more articles in packages based on the fact that several articles may be used within a 24 hour period, and thus one of ordinary skill would be motivated to package the articles for the convenience of a consumer who would prefer to purchase longer-term supplies or quantities of articles, such as ten or more, sufficient to last several days rather than making daily trips to purchase the articles, or rather than making several trips a week to purchase a limited supply of less than ten articles that may only last for a few days.

It is standard practice to place and sell these sanitary articles such as diapers in packages to protect them from the outside environment and keep them clean and sanitary before use because consumers wear these articles in close contact with their body, this is evidenced by the fact that unpackaged diapers, sanitary napkins, tampons etc. are never sold “loose” or unpackaged, or without packaging because the sanitary articles would become contaminated and dirty during transport and storage and a consumer would not purchase unclean or contaminated diapers etc. to place in close contact with their body or with their infant children or toddlers’ body. The examiner cites the fact that Brandon discloses graphics for proper motivation to combiner with Pargass, not for motivation to place the diapers in packages because providing sanitary articles in packages containing more than ten articles in the package for sale to consumers is standard practice.

The examiner cites the fact that Brandon discloses many selections of different types of graphics printed on diapers as evidence that Pargass is analogous art with respect to diapers having graphics because Pargass teaches articles with many different graphics printed on them and thus one of ordinary skill in the art at the time the invention was made would be motivated to look to the teachings of Brandon and Pargass with respect to whether or not ten or more diaper articles that have different graphics printed on them are capable of being placed together within diaper packaging . Pargass clearly teaches that diapers that have different graphics, such as the diapers disclosed by Brandon, and teaches also that ten or more diapers having graphics wherein the graphics have predetermined associations, as recited in claims 1 and 30, are fully capable of being placed in packages.

Therefore, packaging diapers with graphics is not a novel or nonobvious feature of the claimed invention since it is well-known to package diapers with graphics in packages for the convenience of the consumer. Therefore this argument is not persuasive.

With respect to the prior art not teaching all of the limitation of claims 1 and 30, this is the only limitation that Applicant argues the prior art Brandon does not teach, Pargass teaches this limitation and is analogous art for the reasons above and thus is properly combined with Brandon, thus this limitation is taught by the prior art, and therefore the argument that the prior art does not teach all claim limitations is not persuasive.

Additionally, with respect to the argument that the content of the graphics are structural limitations of the article and are not printed matter, this argument is not persuasive because Applicants' arguments allege that the content of graphics is structural, but Applicant does not specifically point out any facts or reasoning to support this allegation. Applicant does not say why or provide any reasons as to how or why the content of the graphics are not printed matter, Applicant does not specifically point out or provide any reasons or explanations as to how or why the content of the graphics comprise structural limitations, Applicant merely asserts that the content of the graphics are structural limitations and are not printed matter without providing any evidence, facts or reason or arguments in support of this allegation or assertion. Therefore Applicant's arguments amount to a general allegation that the content of the graphics are structural limitations without specifically pointing out how the content of the graphics are structural limitations, and thus are not persuasive arguments sufficient to overcome the rejection.

With respect to Applicants arguments that the claimed common theme of the content of the graphics, differences between an invention and the prior art cited against it cannot be ignored

merely because those differences reside in the content of the printed matter and the Office action erroneously excises the claimed common theme from claims 1 and 30 without considering the claimed common theme in the context of the claims as a whole, this argument is not persuasive because the examiner does not excise the claimed common theme from the claims, the examiner has in fact considered the claimed common theme in the context of the claims as whole. The examiner notes that diapers having printed graphics wherein the content of the graphics are not related to a common theme would have the substantially identical structure as diapers where the content of the graphics are related to a common theme.

Furthermore, based upon this consideration and based on the rational underpinnings of law as outlined in the MPEP § 2112.01, III, “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability... The critical question is whether there exists any new and nonobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983).

Here, it is known and taught to print diaper graphics on microporous film comprising diaper backsheets because of its desired breathability properties and also provides a smooth substrate surface for printing, thus there does not appear to exist any new and unobvious functional relationship between the instant printed matter and the substrate; where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.

The cited prior art expressly teaches that it is known to print diaper graphics having different contents on microporous film comprising backsheets as claimed. The prior art also

teaches that it is known to provide the graphics having themes that are suitable ornaments for entertaining or amusing the intended wearers thereby making the purchase of the diapers more attractive to a consumer. Thus there appears to be no new and unobvious functional relationship between the printed graphics and the microporous film material substrate, thus the claimed limitations have not been ignored but have been analyzed in detail with respect to the scope and contents of the prior art, the differences between the prior art and the claims at issue, resolving the level of ordinary skill in the pertinent art, and considering objective evidence present in the instant application considering obviousness or nonobviousness. Based upon these considerations, Applicants' arguments are not persuasive and therefore the examiner respectfully traverses Applicants' arguments and maintains the art rejections of the rejected claims.

The examiner maintains that the Office action has provided detailed analysis based upon the teachings of the prior art and the factual inquiries set forth under 35 USC 103(a) for establishing a background for determining obviousness of the instant claims, additionally, Applicant asserts that a *prima facie* case is not made, but has not specifically pointed out how the language of the claims patentably distinguishes them from the references.

Appellants argument that the analysis of the claims is based on subjective reasoning as to why a patent should not be granted as opposed to objective rationale based on the rule of law is not persuasive in light of the well known practice of packaging items in a manner most convenient for a purchaser, providing articles to the purchaser in one package as opposed to two packages or three packages is not a novel or patentable feature, therefore the single package or two packages limitations does not lend additional patentable weight and is an obvious

modification. *Ormco Corporations and Allesse Orthodontic Appliances, Inc. v. Align Technology, Inc.* (Fed. Cir. 05-1426, 8/30/2006.

Because Applicant has not specifically pointed out how determining how many diapers to place in a package for sale is distinguished from mental processes, and because it is known to package articles in multiple and single unit packaging, it appears that the claimed limitation of a package containing greater than 10 diapers, in combination with the other elements recited in the claim, yield the predictable result of diapers having graphics printed on breathable backsheets for sale in packages of ten diapers or more. Therefore the examiner's position is based on the teachings of the prior art and applicable law, thus Applicant's arguments amount to a general allegation that the examiner's position is based on subjective reasoning rather than objective rational based on rule of law is not persuasive.

With respect to claims 33 and 34 are patentable for the reasons claims 1 and 30 are patentable and also recite that graphics are printed in randomly selected order and the articles are placed in the package in the randomly selected order. These arguments are not persuasive because, as noted supra, Applicant has not specifically pointed out how selecting a random order of graphics based on the content of the graphics placing them in a package in a randomly selected order comprises a structural limitation of the articles since rearranging the order of the articles in the package does not change any of their structural features. Therefore this argument is not persuasive to overcome the teachings of the prior art.

With respect to the limitation that the graphics have a predetermined association including a common theme of the graphics are not mental processes; the decision of how to package the articles in a randomly selected order is not a mental process but are structural

limitations that define the articles as being stacked in the package in a randomly selected order; that the articles of Brandon are capable of being placed in a package in a randomly selected order does not render the pending claims obvious, this argument is not persuasive because it amounts to a general allegation that the predetermined association and themes of the content of the graphics are a structural limitation but Applicant has not specifically pointed out how or why or in what manner they comprise structural limitation, Applicant does not explain how the themes and associations of the content of the graphics relate to the structure of the diaper, and Applicant does not provide any reasons why this limitation renders the claims nonobvious over the cited prior art.

Appellants argue that the order of the articles in the package are structural limitations not the result of mental processes but has not specifically pointed out any facts, reasons, evidence or arguments in support of this allegation.

That Pargass teaches away from the claimed invention because Pargass teaches articles with repeating graphics instead of random graphics is not a persuasive argument because Pargass teaches articles with graphics, the graphics are capable of being repeating or random to the substantially identical extent that the instant articles with graphics are capable of being repeating or random because this is the result of how the seller of the articles groups the articles together for packaging and sale to a purchaser. Additionally, the disclosure of the reference of a preferred embodiment does not teach away from the entire disclosure of the patent, all of which must be considered in the analysis of obviousness, *In re Burckel*, 201 USPQ 67, 70. Pargass teaches diaper articles with graphics printed thereon and the content of the graphics and it would be within the ordinary skill of a routine worker in the art to order the articles in any desired order

since it appears the diapers would perform equally well if their graphics were in a random or repeating order.

Therefore the examiner respectfully traverses Appellants' arguments and maintains the art rejections of the rejected claims.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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